

REMARKS

The Office Action mailed on October 17, 2008, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-21 were pending. By this paper, Applicants do not cancel or add any claims. Therefore, claims 1-21 remain pending.

Applicants respectfully submit that the present application is in condition for allowance for the reasons that follow.

Rejections Under 35 U.S.C. § 102

Claims 16-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Akerfeldt (U.S. Patent No. 5,938,624). In response, in order to advance prosecution, and without prejudice or disclaimer, Applicants have amended claim 16, as seen above, and respectfully traverse the rejections of claims 17-21 for the reasons that follow.

Applicants rely on MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e),” which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Section 103 amplifies the meaning of this anticipation standard by pointing out that anticipation requires that the claimed subject matter must be “*identically* disclosed or described” by the prior art reference. (Emphasis added.) Further, for anticipation, “every element and limitation of the claimed invention must be found in a single prior art reference, **arranged as in the claim.**” (*Brown v. 3M*, 60 USPQ2d 1375 (Fed. Cir. 2001).) It is respectfully submitted that Akerfeldt does not describe each and every element of any of claims 16-21.

I. MISSING ELEMENTS WITH RESPECT TO THE §102 REJECTIONS.

Claim 16: Claim 16 recites a male connector having a conductor that extends in a **retrograde loop** outside the respective connected conductive member before connecting to the respective connected conductive member. In an exemplary embodiment of the invention of claim 16, as seen in Fig. 9 of the application, the conductor 5 extends from the distal direction

of the connector 1 towards the proximal end of the connector, passing through the conductive member 4, and then reverses direction to form a retrograde loop to extend towards the just-mentioned conductive member 4, where it is connected to the just-mentioned conductive member 4.

In contrast, the conductor of Akerfeldt depicted in Fig. 9 does not extend in a retrograde loop as claimed. At most, the conductor of Akerfeldt depicted in Fig. 9 spirals around the core wire 1. Thus, Akerfeldt cannot anticipate claim 16.

Claim 18: Claim 18 requires that at least one of the conductors passes by, immediately before connecting to a respective connected conductive member, a portion of the connector that has a greater stiffness than the stiffness of an entire portion of the connector between the plurality of conductive members. In an exemplary embodiment of the invention of claim 18, as shown in Fig. 9 of the application, the conductor 5 extends through the connected conductive member 4, and is attached to the conductive member 4 on the distal side (with respect to the connector 1) of the conductive member 4. Because the conductor 5 extends through the conductive member 4 just before it attaches to the conductive member 4, it passes by a portion of the connector 1 that has a greater stiffness than the stiffness of an entire portion of the connector between that conductive member 4 and another conductive member 4, immediately before connecting to the first conductive member 4. That is, in this exemplary embodiment, the conductive member 4 stiffens the connector as compared to a section of the connector that does not have a conductive member 4.

The Office Action asserts that Fig. 2 of Akerfeldt anticipateS claim 18, and identifies various components of Fig. 2 that allegedly correspond to certain elements of claim 18. However, nowhere does the Office Action identify where Akerfeldt allegedly teaches that at least one of the conductors passes by, immediately before connecting to a respective connected conductive member, a portion of the connector that has a greater stiffness than the stiffness of an entire portion of the connector between the plurality of conductive members, as is required by claim 18. Because a claim is anticipated only if the prior art teaches each and

every element of a claim, arranged *exactly* as is recited in that claim, Akerfeldt cannot anticipate claim 18 because Akerfeldt does not teach that any of the conductors 7 of Fig. 2 pass by a portion of the connector that has a stiffness as recited, immediately before connecting to a respective connected conductive member 5. Instead, in Akerfeldt, at most, based on the figures, the conductors 7 pass by a portion of the connector that has the same stiffness than the stiffness of an entire portion of the connector between the plurality of the conductive members.

Claims 19-20: Claim 19 recites that “at least one of the conductors passes by, immediately before connecting to the respective conductive member, a portion of the connector that has a greater relative stiffness than a stiffness of an extra continuous outer insulating material between the plurality of conductive members.” Claim 20 recites “an extra continuous outer insulating material between the plurality of conductive members, the conductors being connected to a respective conductive member, wherein at least one of the conductors passes by, immediately before connecting to the respective conductive member, a portion of the connector that has a greater relative stiffness than a portion of the connector between the respective connected conductive member and the extra continuous outer insulating material.” Claims 19 and 20, which were rejected in view of the same teachings as claim 18, are not anticipated by Akerfeldt for at least the reasons detailed with respect to claim 18 above.

Further, claims 19 and 20 recite an extra continuous outer insulating material between the plurality of conductive members, with stiffness requirements associated with a portion of the connector between those extra continuous outer insulating materials and the conductive members. The Office Action does not identify which elements of Akerfeldt are alleged to correspond to the extra continuous outer insulating materials. Thus, the anticipation rejections of claims 19 and 20 are not supported for an additional reason.

Claim 21: Claim 21 recites that “at least one of the conductors passes by, immediately before connecting to the respective conductive member, a portion of the connector that has a greater relative stiffness than a portion of the connector immediately past the proximal and distal ends of the respective connected conductive member.” In this regard, claim 21 is allowable

for at least the reasons that make claim 18 allowable. Further, claim 21 recites that the stiffness is evaluated with respect to the portions of the connector *immediately past the proximal and distal ends of the respective connected conductive member*. The Office Action does not comment on this feature at all when rejecting claim 21 as anticipated in view of Akerfeldt. Thus, the anticipation rejection of claim 21 is not supported for yet another reason.

Rejections Under 35 U.S.C. § 103

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Akerfeldt in view of Vaiani (U.S. Patent No. 5,374,285). In response, Applicants hereby amend claim 1, without prejudice or disclaimer, in order to advance prosecution, and traverse the rejections of various dependent claims.

II. MISSING ELEMENTS WITH RESPECT TO THE §103 REJECTIONS.

Claim 1: With regard to claim 1, Applicants hereby amend that claim to explicitly recite that at least one of the conductors *extends from at least about a distal end of the male connector*, which is beyond a distal end of the respective connected conductive member, towards a proximal end of the respective connected conductive member. In an exemplary embodiment of the invention of claim 1, as seen in Fig. 2 of the application, the conductor 5 travels from beyond the end of the distal end of the male connector 1 (*e.g.*, from the guide wire portion), which is from the distal direction of the conductive member 4, all the way through the conductive member 4 (thus extending along at least a substantial portion of the respective connected conductive member 4) to attach to the respective connected conductive member 4 at the proximal end of the respective connected conductive member 4.

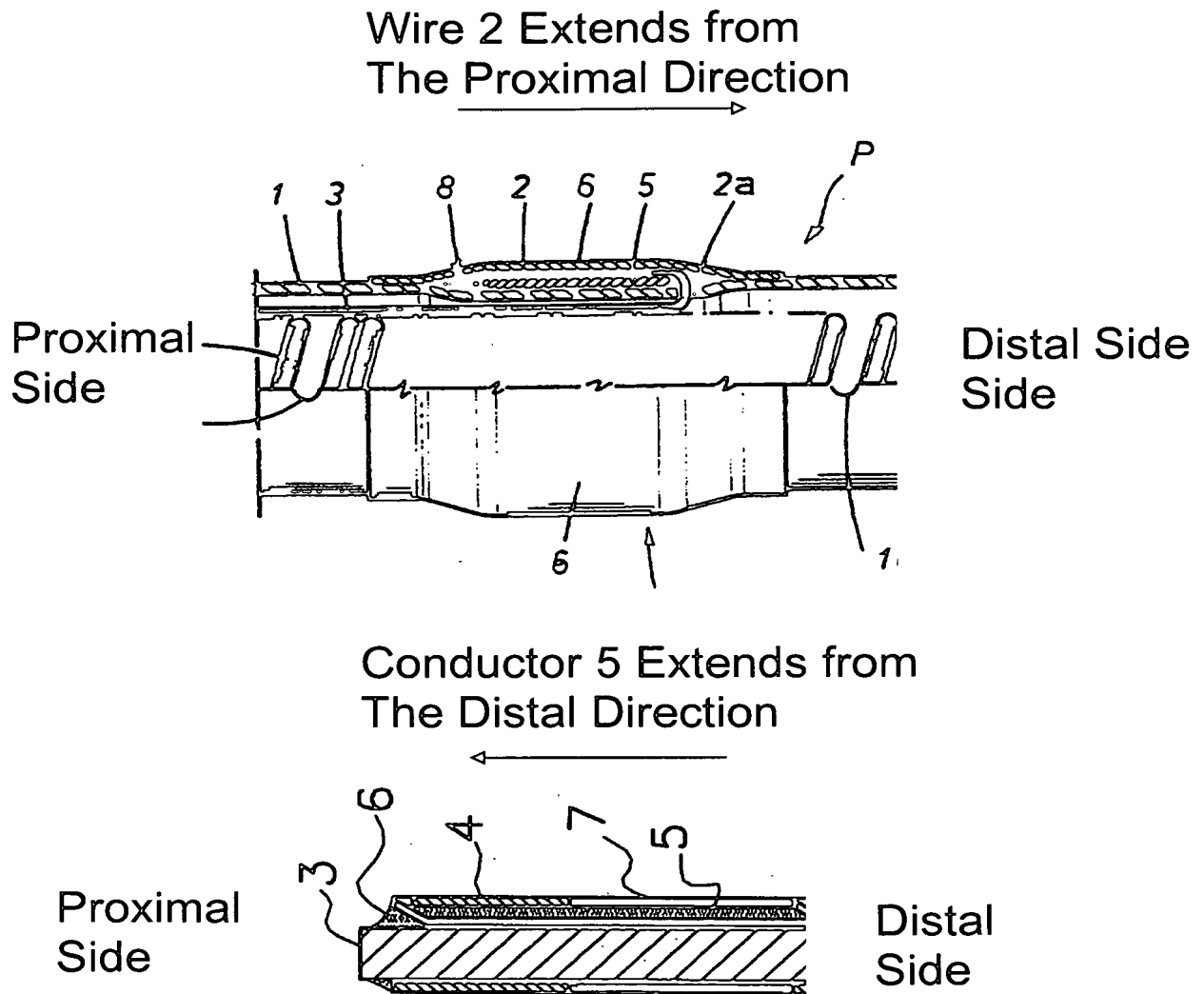
The Office Action recognizes that Akerfeldt does not teach this feature, but asserts that Vaiani teaches the recitations relating to the extension of the conductors. Applicants disagree. First, Vaiani teaches a catheter, not a guide wire. Second, Vaiani does not teach a male connector at the proximal end of the catheter. Vaiani instead teaches a conductive surface positioned along the length of the catheter at the distal end of the catheter. These

conductive surfaces 5 are used for “subcutaneous stimulation of selected areas of the vertebral column . . . and of the spinal bone marrow.” (Vaiani, col. 3, lines 13-16.) That is, the conductive surfaces 5 are not used for a connector of a guidewire (or a catheter). Instead, they are inserted into a human body.

Third, the Office Action does not appropriately characterize what Applicants claim. Specifically, Applicants do not claim “at least one conductor (2) extending . . . in a loop which extends ***beyond the proximal end of the male connector.***” (Office Action, page 4, line 5-7, emphasis added.) No connector of any claim pending recites a conductor that extends beyond the proximal end of the male connector. Indeed, no claim pending at the time the Office Action was mailed contained any feature at all pertaining to any end of the male connector.

Fourth, in this regard, Vaiani does not teach a male connector, and certainly does not teach that any of his wires extend beyond any proximal end of any male connector. The conductors of Vaiani simply do not extend as claimed. Specifically, wire 2 extend from the proximal direction of the catheter towards the distal end of the catheter, and then, connects to the outer surface of the conductive surface 5.

Below is a reproduction of a portion of Fig. 3 of Vaiani, which contrasts distinctly from the reproduction of a portion of Fig. 2 from Applicants' application.



Excerpt From Fig. 2 Of Applicants' Application

Accordingly, Vaiani does not remedy the deficiencies of Akerfeldt, and thus claim 1 is allowable for at least this reason.

All Dependent Claims in General: The Office Action really only addresses claim 1, and generally does not address the claims that depend from claim 1 (*i.e.*, claims 2-15). In this

regard, while the Office Action does address the claims pertaining to the loop, the Office Action asserts that Vaiani teaches a loop that extends from beyond the proximal end of the male connector, as just discussed. No claim recites this feature. Applicants respectfully submit that a *prima facie* case of obviousness has not been established in the Office Action for at least this reason.

Dependent Claims 3, 4, 5, 7-12 and 14 in Particular: Applicants take this opportunity to identify the most glaring cases of dependent claims that are allowable in view of the alleged Akerfeldt-Vaiani combination, notwithstanding the amendment to claim 1, just detailed. That is, these claims recite clear elements that are missing from the alleged Akerfeldt-Vaiani combination. In this regard, it is submitted that the alleged combination does not teach or suggest the additional elements of at least these claims.

III. LACK OF A SUFFICIENTLY ARTICULATED RATIONALE TO MODIFY AKERFELDT TO INCORPORATE THE ALLEGED TEACHINGS OF VAIANI INTO AKERFELDT.

Claim 1: The Office Action asserts that it would have been obvious to modify Akerfeldt

to extend from beyond the distal end of the respective connected conductive member towards the proximal end of the respective connected conductive member in a loop which extends beyond the proximal end of the male connector before extending back towards the distal end of the respective connected conductive member in order to anchor the conductor ***to the best possible effect.***

(Office Action, page 4, lines 8-14, emphasis added, citing Vaiani at col. 3, lines 65-68.)

First, assuming *arguendo* that Vaiani suggests to do this, this still does not suggest modifying the device of Akerfeldt to correspond to any pending claim, as no claim recites a loop extending beyond the proximal end of the male connector, as noted above.

Second, the quoted language of Vaiani regarding allegedly anchoring the conductor “to best possible effect” refers not to the configuration of the wire of Vaiani, but to the

location of the ring 5 (the alleged conductive member) with respect to a hole 2a through which the wire 2 extends. This can be seen by reading the entire teaching of Vaiani at that portion of col. 3 (*i.e.*, reading lines 63-68, as opposed to just lines 65-68 – the portions identified in the Office Action):

the ring 5 is located preferably on the proximal side of the respective hole 2a, relative to the distal stopped end of the outer sheath 1, in such a way **that the bared end of the wire can be anchored to best possible effect.**

(Vaiani, col. 3, lines 63-68.) This passage of Vaiani teaches nothing with respect to the direction of the wires or how the wires extend – only that the ring 5 is located on a preferred side of a hole 2a through which a wire 2 passes. Thus, the rationale for modifying Akerfeldt does not establish a *prima facie* case of obviousness of any of claims 1-15.

Third, assuming *arguendo* that the articulated rationale for modifying Akerfeldt was valid, it provides no rationale for modifying Akerfeldt to arrive at many of the dependent claims. That is, the proffered rationale is, at most, directed to a tiny subset of dependent claims 2-15. In this regard, the articulated rationale does not address why one would have modified Akerfeldt to have the features of at least claims 3, 4, 5, 7, 8, 9, 10, 11, 12 and 14.

In sum, a *prima facie* case of obviousness has not been established due to at least a lack of a sufficiently articulated rationale to modify Akerfeldt. Reconsideration is requested.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or

even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Foreman is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date

1/14/2009

By



FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4747
Facsimile: (202) 672-5399

Martin J. Cosenza
Attorney for Applicants
Registration No. 48,892